

## **REMARKS**

### **Examiner's Response to Amendment in Parent**

Applicant notes with appreciation that the Examiner has deemed the amendment filed by Applicant on October 25, 2001 in the parent case to overcome the rejections set forth in the prior Official Action.

### **Election/Restriction and Rejoinder**

Applicant notes the rejoinder of previously designated species with the elected invention in the final Official Action in the parent case. However, Applicant has herein cancelled claims 43-57, and 59, directed to rejoined species II and III, in order to expedite prosecution of the group I, species I claims, and subject to the right to pursue the cancelled claims, and/or the subject matter therein, in at least one subsequently filed application.

### **Claim Objection**

The Official Action in the parent case objects to Claim 2 in that Claim 2 is dependant on a cancelled claim. Applicant notes that Claim 2, as presented in the "Marked Up Version" of Applicant's Response dated October 25, 2001 reflects a dependence of claim 2 on new claim 74. In light of the fact that the correct dependency was previously established in the "Marked Up Version" of Applicant's Response, only a clean version of claim 2 is presented herein. Applicant respectfully submits that this obviates the objection to claim 2.

### **Claim Rejections:**

In an effort to fully respond to the Official Action in the parent case, the rejections based on 35 USC 112 and 35 USC 103(a) are addressed hereinbelow.

### **Claim Rejections Pursuant to 35 U.S.C. 112**

35 USC §112 Paragraph 2 recites:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

MPEP §2171 recites in relevant part:

If a rejection is based on 35 USC §112, second paragraph, the examiner should further explain whether the rejection is based on indefiniteness or on the failure to claim what applicants regard as their invention. *Ex parte Ionescu*, 222 USPQ 537, 539 (Bd. App. 1984).

The Examiner rejects claims 2-9, 14-19, and 43-75, pursuant to 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Official Action provides a reason for the indefiniteness rejection only for claims 58, 63, and 74, and provides no reasoning regarding claims 2-9, 14-19, 43-57, 59-62, 64-73, and 75. Additionally, the Official Action states Applicant's Response was found to overcome the rejections set forth in the last action, presumably including those rejections previously made pursuant to 35 USC §112, second paragraph for claims 10-12 and 17-19.

As stated in MPEP 706.03(d) in relevant part:

Rejections Under 35 USC 112, second Paragraph

*7.34.01 Rejection, 35 USC 112, 2nd Paragraph, Failure to Particularly Point out and Distinctly Claim (Indefinite)*

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.02 or 7.130.2. This form paragraph should be followed by one or more of the following form paragraphs 7.34.02-7.34.06, as applicable. If none of these form paragraphs are appropriate, a full explanation of the deficiency of the claims should be supplied. Whenever possible, identify the particular term(s) or limitation(s) which render the claims indefinite. If the scope of the claimed subject matter can be determined by one having ordinary skill in the art, a rejection using this form paragraph would not be appropriate. See MPEP §§ 2171-2174 for guidance.

Applicant respectfully submits that the scope of the subject matter in claims 2-9, 13-16, 43-57, 59-62, 64-73, and 75 can easily be determined by one of ordinary skill in

the art. Applicant further submits that the Official Action fails to comply with MPEP 706.03(d), and thus Applicant is unable to assess the particularities of the reasons for the alleged indefiniteness. Therefore, Applicant assumes that the indefiniteness asserted with respect to claims 2-9, 13-16, 43-57, 59-62, 64-73, and 75 is by virtue only of the dependence of those claims on allegedly indefinite claims 58, 63, and 74.

The Official Action specifically rejects claims 58, 63, and 74 on indefiniteness grounds based upon the phrase “without substantial degradation...over time.” For example, claim 58 recites “...wherein said piece of material does not substantially degrade upon exposure to liquid over time”. Applicant has herein amended this phrase to “degradation resistant upon exposure to liquid over extended time”, in order to clarify that the present invention provides a degradation resistance, upon exposure to liquid, over an extended, non-fleeting time period not available in the prior art.

As stated in the previous Office Action response:

“During the Interview with the Examiner, Applicant noted that the present invention is directed to a pad that may be placed in solution, such as in a shelf-stored medicated solution, over an extended period of time, and, as such, the pad evidences highly absorbent properties without degradation due to extended exposure to such solutions. In accordance with the suggestions of the Examiner, new claims 63 and 74, and now amended claim 58 of the instant application, clarify that the non-woven pad displays high absorbency properties that allow the material to absorb large quantities of solution over time without substantial degradation of the material. Applicant submits that certain paper products, such as the paper towel disclosed in McFarland and the diaper backsheet disclosed in Schlein, would suffer substantial degradation in instances necessitating high absorbency levels over extended time periods.”

As it is commonly known that paper towels and paper diaper materials, as disclosed in McFarland and Schlein, may tear or otherwise physically fall apart, i.e., suffer "substantial degradation," upon being soaked in liquid, such as for extended, non-fleeting periods of time, such as over the course of minutes or hours, it is respectfully submitted that the claims of the present invention make clear that the claims are directed to materials that do not exhibit such degradation characteristics. Thus, the present Amendment provides clear terminology consistent with the terminology in the prior art, thereby avoiding indefiniteness to one of ordinary skill in the art, and thereby complying with the agreement reached in the Interview of September 4, 2001 in the parent case.

Applicant further respectfully submits that a pad material specifically referred to in the specification is SONTARA® fabric type S-8100. As would be apparent to one of ordinary skill, particularly in light of an Information Disclosure Statement submitted on October 25, 2001, the SONTARA fabric properties include:

Absorbency—Since Sontara® Technologies fabrics can be made with a variety of fibers, the ability to absorb various liquids can be controlled without the use of surface modifying agents. That's why our 100% polyester styles offer excellent solvent absorbing properties — and our cellulosic/polyester and rayon/polyester styles are outstanding for absorbing aqueous liquids.

Strength & durability—Sontara® Technologies fabric has exceptional resistance to tearing, and maintains over 75% of its strength when wet. In addition, our spunlaced fabrics offer high machine/cross directional strength ratios.

This exemplary description highlights the absorbency, strength, and durability, over time, of the present invention, such as the maintenance over time of 75% of absorbent strength even when wet. This maintenance of 75% of absorbency evidences a "degradation resistance" not known in the prior art, such as a degradation resistance over time periods longer than those fleeting periods of absorbency and durability in McFarland and Schlein, and of the type of materials taught in McFarland and Schlien, such as, specifically, diapers and paper towels. In addition, in the Information Disclosure Statement filed concurrently herewith, it is illustrated that the Sontara fabrics may be used

repeatedly, thereby illustrating that the durability and absorbency of the fabric is maintained indefinitely, and, thus, for an “extended time”, unlike the materials of McFarland and Schlien. Such descriptions clearly provide, for one skilled in the art, a definiteness for the limitation terminologies in the claims as currently pending. Further, Applicant notes that, if the exemplary description cited above would provide an adequate definition to enable one of ordinary skill to assess the limitations of the claim without undue experimentation, the claims as defined cannot be indefinite. Orthokinetics v. Safety Travel Chairs Inc., 1 USPQ2d 1081,1088 (CAFC 1986).

Therefore, Applicant respectfully submits that claims 63, 74, and 58 are now in condition for allowance.

#### **Claim Rejections Pursuant to 35 U.S.C. 103(a)**

35 USC 103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

MPEP 706.02(j) recites:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner rejects claims 2-9, 14-19, 58, and 60-75, pursuant to 35 U.S.C. 103(a), as unpatentable over either McFarland et al (6096412), or Schlein et al (5458590), in view

of either Dainippon (JP-63091234A), Hayashi (5776854), or Morikawa et al (6161928) and Krzysik et al (5601871).

Applicant respectfully submits that, in order to establish a prima facie 35 USC §103(a) rejection, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings. MPEP 706.02(j). “The examiner can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” In re Sang Su Lee, 00-1158, (Serial No. 07/631,240) , (Fed.Cir.2002) citing In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed.Cir.1992).

The Official Action states that it would have been obvious to a person having ordinary skill in the art to utilize and/or combine the vehicles taught by Dainippon, Hayashi, and Morikawa into the dyes of McFarland and Schleinz, due to a motivation to provide the ink with more uniform dispersion and improved mechanical strength. The Federal Circuit, with regard to 35 USC §103(a) obviousness rejections, has made it clear that “[t]he need for specificity pervades.” See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed.Cir.2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner *claimed*” [emphasis added]). In the instant case, no specificity is provided that one of skill in the art would have combined, or would have been motivated to combine, the relevant teachings of the references in the manner *claimed*, as has been repeatedly required by the Federal Circuit. “The factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority.” In re Sang Su Lee, (Fed.Cir.2002).

For example, the Official Action states that “[i]f Krzysik’s process does not inherently form the image in register then it would have been obvious to a person having

ordinary skill in the art to print both sides of the web created by McFarland or Schleinz and Dainippon, Hayashi, or Morikawa in register." However, Krzysik does not explicitly teach forming an image in register, and no motivation is specifically provided to use Krzysik in an application wherein the image is formed in register. Thus, forming an image in register is not inherent to Krzysik, and no suggestion or motivation exists, or has been specifically shown, in McFarland or Schleinz, and/or in Dainippon, Hayashi, or Morikawa, to print in register on both sides of a non-woven web, such as that of Krzysik. The Official Action states that the motivation would be "the desire to render the web more attractive to consumers." Applicant respectfully submits that a claimed invention is not obvious based merely on this assertion that it would have been "obvious [or desirable] to try." Amgen, Inc., v. Chugai Pharmaceutical. Co., Ltd., 927 F.2d 1200 (Fed.Cir.1991).

In re Bozek is cited in the Official Action for the proposition that references need not be evaluated by that which is specifically disclosed. However, the Federal Circuit, in In re Sang Su Lee, 00-1158, (Serial No. 07/631,240), (Fed Cir. 2002), reversed a rejection based on a motivation to combine. "Bozek did not hold that common knowledge and common sense are a substitute for evidence, but only that they may be applied to analysis of the evidence. Bozek did not hold that objective analysis, proper authority, and reasoned findings can be omitted ... Nor does Bozek, after thirty-two years of isolation, outweigh the dozens of rulings of the Federal Circuit and Court of Customs and Patent Appeals that determination of patentability *must be based on evidence*." (emphasis added ). Applicant respectfully submits that no objective evidence has been set forth in the Official Action as to any suggestion or motivation to combine the references as cited in the present Office Action, and that this lack of evidence is adverse to the decision in Sang Su Lee.

To establish a prima facie 35 USC §103(a) rejection there must be a reasonable expectation of success. MPEP 706.02(j). Mere motivation is not sufficient. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant's declaration, submitted herewith, suggests a long-felt need, addressed solely by the invention claimed in the instant

application, as evidenced by the commercial success of the instant application. Declaration of Dean Shacklett. Thus, a motivation to generate the claimed invention was present in the prior art, and the lack of such an invention suggests that the combination of prior art, including that prior art combination referenced in the Official Action, did not provide a reasonable expectation of success prior to the instant application.

To establish a prima facie rejection under 35 USC §103(a), the prior art references must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and may not be based on Applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). However, the Official Action admits that “[t]he combination of the references set forth above do not seem to specifically teach printing both sides of a substrate in register.” Since, in accordance with this admission in the Official Action, a prima facie case for an obviousness rejection is absent in the instant case, Applicant respectfully submits that the 35 USC §103(a) rejection is not properly established.

With respect to comments regarding inherent properties of Applicant's claimed subject matter, Applicant notes that it is unclear the “properties” to which the Office Action refers. Applicant further notes that the properties generated in the instant application are the result of the printing material, inks, ink vehicles, and printing methodologies selected by Applicant, and, therefore, the generation of the new, specific properties generated by the aforementioned combination of methodologies cannot be apparent *in light of the prior art*, or inherent *in the prior art*, if the combination that produces the properties is not known in, or obvious in light of, the prior art. Applicant respectfully submits that the combination selected, and, therefore, the properties resultant therefrom, are not known in, or obvious in light of, the prior art, and thus are not inherent based on the known art. Clearly, new properties resultant from new subject matter not known in the prior art may be produced by the new combination taught by Applicant, but, as set forth above, Applicant's own teaching cannot be used to make a case for the obviousness of Applicant's teachings. Thus,



Applicant submits that the inherency of new properties to a new combination, as taught by Applicant, is not relevant to the allowability of the subject matter claimed by Applicant.

Similarly, the size, shape and thickness of the nonwoven material are respectfully submitted as relevant as additional limitations to certain of the patentable subject matter discussed hereinabove, and thus this statement in the Official Action is not addressed further herein.

### **Conclusion**

Applicant has herein respectfully traversed the claim 2 objection, and the 35 USC §112 second paragraph rejection of claims 2-9, 11-19, 43-75, in the Official Action in the parent case. In light of the ordinary skill in the art, claims 58, 63, and 74 are herein respectfully submitted by Applicant as not indefinite. Applicant herein respectfully submits that the 35 USC §103(a) rejections in the parent case are without merit, at least in light of the fact that no suggestion or motivation to combine has been provided. Thus, Applicant respectfully requests consideration of the subject application in light of the reasons set forth herein. Consequently, a Notice of Allowance for all pending claims is earnestly solicited.

Respectfully Submitted,

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the Claims:**

58. (Twice Amended) A pad comprising:

a piece of non-woven material wherein the material is selected from the group consisting of a polyester and a polyester cellulose blend, and wherein said piece of material [does not substantially degrade upon exposure to liquid over time] is degradation resistant upon exposure to liquid over extended time; and

a first ink printed on a first surface of the piece of non-woven material, wherein the first ink comprises a vehicle selected from the group consisting of nitrocellulose, polyamid, vinyl acrylic, shellac, and combinations of nitrocellulose, polyamid, vinyl acrylic and shellac, wherein the first ink is substantially non-leaching due to the vehicle selected.

63. (Amended) A pad for carrying liquid, comprising:

a piece of non-woven material, wherein the piece of material is [absorbent without degradation of the piece of material over time] degradation resistant upon exposure to liquid over extended time;

a first printed ink on a first surface of the material, wherein a vehicle for the first ink is selected from the group consisting of nitrocellulose, polyamid, vinyl acrylic, shellac, and combinations of nitrocellulose, polyamid, vinyl acrylic and shellac;

a second printed ink on at least one of the first or a second surface of the material, wherein a vehicle for the second ink is selected from the group consisting of nitrocellulose, polyamid, vinyl acrylic, shellac, and combinations of nitrocellulose, polyamid, vinyl acrylic and shellac;

wherein the first ink is substantially in register with the second ink, and wherein the first ink does not visibly leach through the piece of material or into the second ink, and wherein the second ink does not visibly leach through the piece of material or into the first ink.

74. (Amended) A pad for carrying liquid, comprising:

a piece of non-woven material absorbent [over time] to an amount of the liquid at least about 1.5 times a weight of said piece of material, said material being [without substantial degradation of said piece of material over time] degradation resistant upon exposure to liquid over extended time;

a first printed ink on a first surface of said piece of material, wherein said first ink comprises a vehicle selected from the group consisting of nitrocellulose, polyamid, vinyl acrylic, shellac, and combinations of nitrocellulose, polyamid, vinyl acrylic and shellac, and wherein said first ink is substantially non-leaching due to the vehicle selected;

a second printed ink on at least one of the first or a second surface of said piece of material; wherein said first ink is substantially in register with said second ink.